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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/452,811	12/02/1999	MASAYUKI CHATANI	991202	1782

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EXAMINER

DINH, DUNG C

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 06/25/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Applicati n N .

09/452,811

Applicant(s)

CHATANI, MASAYUKI

Examiner

Dung Dinh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period of Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-44 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-44 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6,9.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

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DETAILED ACTION

Specification

The abstract of the disclosure is objected to because it is longer than 150 words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

Claim Objection

Claim 43, "said detachable storage media" lacks proper antecedent basis.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 20-21 are rejected under 35 U.S.C. 102(b) as being anticipated by Uranaka US patent 5,937,158.

As per claim 20, Uranaka teaches a detachable storage media installable in a console, the media having data structure comprising:

trigger data [fig.7 700, 704] and associated auxiliary media content items [col.11 lines 20-25];

a media ID for identifying the storage media [fig.7 701, 702, 703];

an authentication code [fig.7 707] for authenticating access to a server via a network [fig.8 step 803].

As per claim 21, Uranaka teaches the media containing network software for establishing connection to the network [col.13 lines 2-25].

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Claims 1-8, 20-21, 22-23, 25, 42-44 are r jected under 35 U.S.C. 102(e) as being anticipated by Collart US patent 6,453,420.

As per claim 1, Collart teaches a system for providing access to primary media content in digital form, comprising:

a server network [fig.2] comprising a download management server, database storing user information and primary media content [fig.2 #232, #234, #236];

a client console connectable through a bi-directional communication network to download management server [fig.2];

a detachable storage media [220] installable in the client console, the detachable storage media having data structure thereon comprising auxiliary media content and associated trigger data items [inherent from col.22 lines 41-60], and user identifier [col.6 lines 1-11];

wherein the user identifier is upload to the server to enable access to specified content and user information is downloaded to the client console to trigger execution of specific auxiliary media content items [col.15 lines 10-35, col.19 lines 1-9].

As per claims 2 and 4, Collart teaches the user identifier comprises media ID indentifying the storage media and authenitication code [col.15 lines 10-35, col.19 lines 1-9].

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As per claims 3 and 5, Collart teaches using the user identifier to limit access to specified primary content [col.15 lines 30-35, col.23 lines 36-40].

As per claims 6-7, Collart teaches providing a program for providing network access and code to causes execution of program stored on the client console for providing network access [col.14 lines 25-59].

As per claim 8, Collart teaches the client has local fixed storage device [apparent from col. 26 lines 1-25 in order to store the update and application information].

As per claims 20 and 22, they are rejected under similar rationale as for claim 1 above.

As per claims 21 and 23, Collart teaches providing a program for providing network access and code to causes execution of program stored on the client console for providing network access [col.14 lines 25-59].

As per claim 25, Collart teaches storing a record of the viewing and uploading to the server [col.24 lines 7-9].

As per claim 42, Collart teaches a server network connectable with a client console via a communication network for providing access to primary content, comprising:

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a download management server, database storing user information and primary media content [fig.2 #232, #234, #236], wherein user identifier is uploaded from the client to the server allowing the user to download information corresponding to the user identifier to be downloaded to the console and allow specific primary content item to be downloaded [col.15 lines 10-35, lines 30-35, col.19 lines 1-9, col.23 lines 36-40].

As per claim 43, Collart teaches the user identifier comprises media ID indentifying the storage media and authentication code [col.15 lines 10-35, col.19 lines 1-9].

As per claim 44, Collart teaches using the user identifier to limit access to specified primary content [col.15 lines 30-35, col.23 lines 36-40].

Claims 27-28, 40-41 are rejected under 35 U.S.C. 102(e) as being anticipated by Hoffberg et al. US patent 6,400,996.

As per claim 27, Hoffberg teaches a system for assessing a fee for auxiliary content comprising:

a server [service provider];
auxiliary content provider [advertiser]; and

a client node [user] connectable with the server through a communication network for executing playback of auxiliary content stored on a detachable storage media [col.63 lines 41-42],

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creating record indicating playback of the auxiliary content, and uploading the record to the server [col.63 lines 12-18],

wherein a fee to the auxiliary content provider is assessed based on the playback record [col.60 lines 10-15].

As per claim 28, it is rejected under similar rationale as for claim 27 above.

As per claim 40, Hoffberg teaches a server network [service provider] for assessing a fee for auxiliary content [commercials] of auxiliary content provider [advertiser], comprising: a download manager server [col.63 line 25 subscription television system], a customer database and content database [inherent in order to keep track of subscriber and providing content],

wherein the sever receives record indicating playback of the auxiliary content item from a client console and accumulate the playback record to assess a fee to the auxiliary content provider [apparent from col. 60 lines 10-17, col.62 lines 50-68, col. 63 lines 12-24, col.64 lines 39-43].

As per claim 41, Hoffberg teaches the playback record is used to update the customer database [col.64 lines 30-43].

Claim Rejections - 35 USC § 103

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The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 26 is rejected under 35 U.S.C. 103(a) as being unpatentable over Collart US patent 6,453,420.

As per claim 26, Uranaka does not specifically disclose the console being a personal digital assistant (PDA). The type of device for playing the media would clearly have been a matter of design choice. It would have been obvious for one of ordinary skill in the art to use a PDA because it would have enabled the user to be mobile and to have computing functionality while using the media.

Claims 9-19, 24, 29-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Collart US patent 6,453,420 and further in view of Hoffberg et al. US patent 6,400,996.

As per claim 9, Collart teaches a method comprising the steps of:

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establishing communication to download management server
[col.14 lines 10-13];

transmitting user identifier contained on the local storage
media and a request for primary media content to the server
[col.14 lines 51-59];

downloading from the server to the client console primary
media content and user information [col.20 line 60 to col. 21
lines 6];

accessing auxiliary content on the detachable storage on
the basis of the returned user information and overriding
playback for enabling viewing of the primary media [col.23
lines 55 to col.24 9];

storing a record of the viewing and uploading to the server
[col.24 lines 7-9].

Collart does not teach selectively overriding playback of
the auxiliary content. Hoffberg teaches a method of providing
auxiliary content on detachable media [col.63 lines 40-44] that
enables the user to selectively playback the auxiliary content
[col.64 lines 35-42] to earn subsidy for viewing of primary
content [col.60 lines 10-15]. Hence it would have been obvious
for one of ordinary skill in the art to combine the teaching of
Hoffberg with Collart because it would have enabled the user to

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control his option of viewing the auxiliary content for subsidy benefit [see Hoffberg col.60 lines 10-15].

As per claim 13, it is rejected under similar rationale as for claim 9 above. Collart teaches determining whether connection to the network is required for the operation of the client console [apparent from col.14 lines 5-39: case 2 & 3].

As per claim 24, Collart does not specifically disclose enabling the user to decide whether or not to view the auxiliary content item. The obviousness rationale is as stated for claim 9 above.

As per claims 29+32, 33, they are rejected under similar rationale as for claim 9 above. Hoffberg teaches assessing fee to auxiliary content provider (advertiser) based on playback records accumulated by the server [see col.60 lines 10-24].

As per claims 10 and 30, Collart teaches having media identifier and authentication code [col.19 lines 1-3]. Collart teaches using the identifier and code to restrict access to primary content [col.23 lines 35-40].

As per claims 11 and 31, it is apparent that a comparison step is done in order trigger a particular content on the detachable media.

As per claim 12, Hoffberg teaches storeing primary content on local storage [col.59 lines 10-15].

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As per claims 14-15, and 34-35, Hoffberg discloses monitoring the user "veto" viewing of auxiliary content [col.64 lines 40-43]. It is apparent that the system as modified would have the step of polling to determine if the user overrides the playback of auxiliary content and to update viewing record accordingly. It would have been obvious for one of ordinary skill in the art to do so because it would have enabled the system to keep accurate record of the user's viewing.

As per claims 16-18, and 35-38, the timing of the upload of the viewing record would clearly have been a matter of design choice. It would have been obvious for one of ordinary skill in the art to upload the viewing record at various times as the situation required.

As per claims 19 and 39, Collart teaches prompting the user for user information and to associate with the user with the media identifier [col.20 lines 59-60].

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dung Dinh whose telephone number is (703) 305-9655. The examiner can normally be reached on Monday-Thursday from 7:00 AM - 4:30 PM. The examiner can also be reached on alternate Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenton Burgess can be reached at (703) 305-4792.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group 2100 Customer Service whose telephone number is (703) 306-5631.

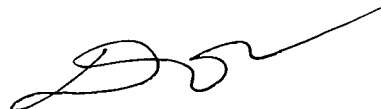
Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, DC 20231

or faxed to:

(703) 746-7239, (for formal communications intended for entry)
(703) 746-7240 (for informal or draft communications, please label "PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington. VA, Fourth Floor (Receptionist).



Dung Dinh
Primary Examiner
June 19, 2003